REMARKS

This response intended as a full and complete response to the Final Office Action dated August 19, 2004. In the Office Action, the Examiner notes that claims 2-40 and 42-48 are pending, of which claims 2-40 and 42-48 stand rejected. By this amendment, claims 2, 22, and 47 have been amended, claims 1, 21, and 41 continue as being cancelled, new claims 49 and 50 have been added, and claims 3-20, 23-40, 42-43, and 45, 46 and 48 continue unamended.

In view of both of the amendments presented above and the following discussion, the Applicant submits that none of the claims now pending in the application are obvious under the provision of 35 U.S.C. §103. Thus, the Applicant believes that all of these claims are now in allowable form.

REJECTIONS

35 U.S.C. §103

Claims 2-20, 22-40 and 42-48

The Examiner has rejected claims 2-40 and 42-48 under 35 U.S.C. §103 as being obvious over Sicher et al. (U.S. Patent No. 6,385,195, issued May 7, 2002, hereinafter "Sicher") in view of Fitch et al. (U.S. Patent No. 6,647,389, issued November 11, 2003, hereinafter "Fitch"). The Applicant respectfully traverses the rejections.

The Applicant has amended independent claims 2, 22, and 44 to further clarify the features the Applicant considers as being inventive. For example, independent claim 2 (and similarly independent claims 22 and 44), as amended, recites:

> "A method for accepting streamed media packets sent from an content provider and converting said streamed media packets to a pulse code modulated (PCM) signal stream, said method comprising the steps of:
>
> receiving, at a first interface, a request for a specified media content available from said content provider, said specified media content comprising at least one of live and archived media content;

establishing, at said first interface and responsive to receipt of said request, a session with said content provider for said requested media content;

receiving, at said first interface, said streamed media packets corresponding to said specified media content, said streamed media packets being encoded media packets adapted to one of a plurality of encoded streaming media formats;

transcoding, at said first interface, said streamed media packets received from said content provider, to form a PCM signal stream corresponding to said specified media content; and:

launching, from said first interface, said PCM signal stream onto a network operable to convey said PCM signal stream to a user making said request." (emphasis added).

"The test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Furthermore, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added)."

The combined references fail to teach or suggest "establishing, at said first interface and responsive to receipt of said request, a session with said content provider for said requested media content," "receiving, at said first interface, said streamed media packets corresponding to said specified media content," "transcoding, at said first interface, said streamed media packets received from said content provider, to form a PCM signal stream corresponding to said specified media content," and "launching, from said first interface, said PCM

signal stream onto a network operable to convey said PCM signal stream to a user making said request." Therefore, the combination of Sicher and Fitch fails to teach or suggest the Applicant's invention as a whole.

In particular, the Sicher reference attempts to solve a problem of performing interworking functions between mobile-specific voice encoding protocols on the mobile radio side of a connection and Voice-over-internet Protocol (Voice-over-IP) encoding protocols (sometimes referred to as Voice-on-Net or VON) on the Internet side of the connection (see Sicher, col. 1, lines 55-64). The Sicher reference solves this problem by disclosing an enhanced interworking function module (E-IWF) that provides the means for a mobile station to interface voice and fax with the Internet. That is, the IWF enables a mobile subscriber to make an IS-136 (digital) voice call to another Internet subscriber or to a landline terminal via an IP based network (e.g., the internet) without going through the PSTN and an extra analog conversion (see Sicher, col. 4, lines 50-54).

More specifically, live voice signals are encoded in a mobile station into voice frames which are multiplexed in a base station and transmitted to the E-IWF. The E-IWF transcodes the voice frames in a first codec into an isochronous stream of digitized voice samples, such as a pulse code modulator (PCM) signal stream. The isochronous PCM stream is then transcoded, via a second codec, into a voice-over-IP (VoIP) format. The output of the second codec is a service data unit (SDU) which is framed utilizing a transport layer protocol into segmented datagrams. The IP datagram stream is then carried by one of a plurality of lower-layer protocol, such as, for example, CSMA/CD, frame relay, among others. (See Sicher, column 3, lines 17-34 and col. 6, lines 28-61). That is, E-IWF of the Sicher reference performs two transcoding steps to first change the voice AFR frames into a PCM signal, and then transcode the PCM signal into segmented datagrams prior to transmitting such datagrams.

The Applicant's invention differs from the Sicher reference, since the Applicant's invention provides for "establishing, at said first interface and

responsive to receipt of said request, a session with said content provider for said requested media content." That is, the Applicants Invention receives, at the first interface, a request for specified media content, establishes a session with a content provider, and then establishes a session, at the first interface with the content provider. Once the session is established, the first interface receives the streamed media packets corresponding to the specified (i.e., requested) media content. Thereafter, the transcoding and launching steps are performed at the first interface.

Thus, the operational aspects as between the combined references and the Applicant's invention are different. The cited references disclose sending a voice signal (AFR frames) to the E-IWF, transcoding the received frames into PCM signals, and then transcoding again into datagrams (packetized information) when being sent over the Internet. By contrast, the Applicant's invention does not transcode signals sent by the requester for media content. Rather, the request sent by the user is merely to initiate (i.e., establish) a session as between the first interface and the content provider.

Applicant respectfully submits that the Examiner has not set forth a proper case for rejecting the claims under 35 USC Section 103 of the Patent law. In independent claims 2, 22, and 44, for example, the Applicant sets forth a novel methodology and apparatus for providing streamed media content from a packet switched network, such as the Internet, to a client device, such as a cellular phone, which does not support streaming since the client devices do not have decoders or streaming controls. Applicant was the first to provide a method and apparatus that sends a request for a session for content to a first interface (e.g., MGA), where the first interface then establishes a session with a media content provider. Applicant's invention is novel and non-obvious because such client devices are unable to receive such streamed (i.e., packetized) media content.

In making the Section 103 rejection, the Examiner relies on Fitch to show that the media content comprises at least one of live and archived media content. This leads to the combining of the Sicher reference that discloses transcoding

AFR frames to PCM signals, and then transcoding the PCM signals to datagrams, with Fitch to purportedly render the Applicant's present invention obvious. There is, however, no suggestion to apply the teachings of Fitch in a manner as set forth by the presently claimed invention as is required to make such a rejection.

Applicant readily admits that various signals being transformed into PCM signals were known in the art at the time of the invention, however, applicants specifically claimed invention, which addresses a critical aspect of live and archived media content was clearly not known in the manner as recited in the Applicant's claims. In a prominent CCPA decision addressing obviousness under Section 103, the court stated that "[I]t should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." ***In re Nomiya***, 184 USPQ 607, 612 (C.C.P.A. 1975)

As applicant has stated, transcoding AFR frames to PCM signals, and the PCM signals to datagrams are "old". "There is no basis in the law, however, for treating combinations of old elements differently in determining patentability. . . . The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" ***Fromson v. Advance Offset Plate, Inc.***, 225 USPQ 26, 31 (Fed. Cir. 1985) quoting *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d at 1462, 221 USPQ at 488. Applicant respectfully submits, as is stated by the Nomiya court that "[t]here must, however, be a reason apparent at the time the invention was made to the person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight."

"One of the more difficult aspects of resolving questions of non-obviousness is the necessity 'to guard against slipping into use of hindsight.'

. . . Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention 'would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" ***In re Carroll***, 202 USPQ 571, 572 (C.C.P.A. 1979) (quoting ***Graham v. John Deere Co.***, 383 U.S. 1, 36 (1965))

Applicant respectfully submits that the Examiner is applying an "obvious to try" test in making her Section 103 rejections. However, this is not the standard of the law. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992) In the case of the present invention, the prior art simply does not suggest the desirability of modification in order to reach applicant's invention. That is, nowhere in the Sichter reference, which the Examiner states as disclosing a majority of the features of the Applicant's invention except for the live and archived media content, is there any suggestion that it is desirable to establish a session by a first interface (i.e., MGA) for media content comprising at least one of live and archived media content, then upon receiving such requested live or archived media content, transcoding the received media content into a PCM signal stream, and sending such PCM signal stream to a client device, such as a cellular phone. Therefore, the Sicher and Fitch references fail to teach or suggest, either singularly or in combination, the Applicant's invention as a whole.

As such, the Applicant submits that independent claim 2, as amended, is not obvious and fully satisfies the requirements under 35 U.S.C. §103 and is patentable thereunder. Likewise, independent claims 22 and 44, as amended, recite similar limitations as recited in independent claim 2. As such, and at least for the same reasons as discussed above, the Applicant submits that independent claims 22 and 44 are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 3-20,

23-40, and 45-48 respectfully depend, either directly or indirectly, from independent claims 2, 22, and 44, and recite additional features thereof. As such and at least for the same reasons as discussed above, the Applicant submits that these dependent claims are also not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the rejection be withdrawn.

CONCLUSION

Thus, the Applicant submits that the pending claims are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg or Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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